

**REMARKS**

**I. STATUS OF CLAIMS**

With entry of this amendment, Claims 47, 61-75, 78-79, and 81-82 are pending. Support for the amendment is found in the specification as filed, and in the international and French applications. For example, support for the amendment is found in original claim 5, and in the specification at page 6, line 24, to page 7, line 6. Accordingly, no new matter has been added. Applicants respectfully request consideration of the amended claims and arguments, continued examination of the application, and timely allowance of the pending claims.

**II. The Claims Are Not Obvious Under 35 U.S.C. § 103**

**Yu in view of Coyle and Greenberger**

The Office has rejected claims 47, 61-65, 67, and 69-81 under 35 USC§ 103(a) as being obvious over *Yu et al.* (U.S. Patent No. 5,506,133) ("*Yu*") in view of *Coyle et al.* (Science, 262:689-695, 1993) ("*Coyle*") and *Greenberger* (U.S. Patent No. 5,599,712) ("*Greenberger*") for the reasons set forth on pages 3-5 of the final Office Action. Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, the Examiner must demonstrate that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. M.P.E.P. § 2143. In the present case, Applicants contend that the Examiner has failed to make a *prima facie* case of obviousness because this requirement has not been met.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

As a basis for its rejection, the Office alleges that *Yu* "recites the use of a human superoxide dismutase (SOD-4) to treat human diseases involving excess free radicals." (Office Action, page 3.) The Office admits that *Yu* "does not teach the specifics of generating adenoviral vectors capable of expressing SOD genes and does not provide a review of the roles of different SODs in reducing the levels of free radicals in humans." (*Id.*) The Office alleges that the secondary references, *Coyle* and *Greenberger*, "simply provide teachings on the specifics of generating adenoviral vectors (these procedures are well known in the art) and provide a review of the link between free radicals and disease in humans." (*Id.*, page 4.) The Office concludes that it would have been obvious to combine *Yu*, *Coyle*, and *Greenberger*.

because *Yu et al.* specifically teaches that adenoviral vectors (which can be made by the methods disclosed by *Greenberger et al.*) can be used to deliver an SOD gene to target cells for the express purpose of alleviating diseases marked by an excess of free radicals and because *Coyle et al.* indicates that a reduction in the levels of free radicals can alleviate some human diseases characterized by excess free radical levels.

(*Id.*, page 5.)

The Federal Circuit requires a showing of a suggestion or motivation to modify the teachings of prior art references. See, e.g., *In re Dembiczak*, 50 USPQ.2d 1614 (Fed. Cir. 1999). Modifying prior art references without evidence of such a suggestion or motivation simply takes the inventor's specification as a blueprint for piecing together the prior art to defeat patentability, which is the essence of hindsight. *Dembiczak*, 50 USPQ.2d at 1617. This is why the Federal Circuit places a burden on the Office to present "clear and particular" evidence showing motivation to combine or modify. *Id.* at 1617.

In this application, *Yu* does not teach or suggest administering a replication defective, recombinant adenovirus comprising a DNA sequence which encodes superoxide dismutase-1 (SOD-1) for treating the diseases recited in claim 47 as amended. In view of the present amendment, Applicants contend that one of ordinary skill in the art reading *Yu*, *Coyle*, and *Greenberger* would not have been motivated to substitute *Yu*'s SOD-4 sequence with Applicant's SOD-1 sequence to devise the presently claimed method, particularly in light of the Office's admission that *Yu* "does not teach the specifics of generating adenoviral vectors capable of expressing SOD genes and does not provide a review of the roles of different SODs in reducing the levels of free radicals in humans." (Office Action, page 3.)

In view of the present amendment, Applicants submit that the Office has not presented "clear and particular" evidence showing that one of ordinary skill in the art would have been motivated to modify the teaching of *Yu* to arrive at the claimed invention. Accordingly, Applicants respectfully request that the Office reconsider and withdraw the rejection.

***Yu* in view of *Coyle*, *Greenberger*, and *Engelhardt***

The Office has rejected claims 66 and 82 under 35 USC§ 103(a) as being obvious over *Yu* in view of *Coyle*, *Greenberger*, and *Engelhardt et al.* (PNAS, 91:6196-6200, 1994) ("*Engelhardt*") for the reasons set forth on pages 5-6 of the final Office Action. Applicants respectfully traverse the rejection.

Applicants incorporate by reference the above argument directed to *Yu*, *Coyle*, and *Greenberger*, and submit that *Engelhardt* does not provide any "clear and particular" evidence showing that one of ordinary skill in the art would have been

motivated to modify the teaching of Yu to arrive at the claimed invention.

Accordingly, Applicants respectfully request that the Office reconsider and withdraw the rejection.

**Yu in view of Coyle, Greenberger, and Le Gal La Salle**

The Office has rejected claim 68 under 35 USC§ 103(a) as being obvious over Yu in view of Coyle, Greenberger, and Le Gal La Salle et al. (Science, 259:988-990, 1993) ("Le Gal La Salle") for the reasons set forth on pages 7-8 of the final Office Action. Applicants respectfully traverse the rejection.

Applicants incorporate by reference the above argument directed to Yu, Coyle, and Greenberger, and submit that Le Gal La Salle does not provide any "clear and particular" evidence showing that one of ordinary skill in the art would have been motivated to modify the teaching of Yu to arrive at the claimed invention. Accordingly, Applicants respectfully request that the Office reconsider and withdraw the rejection.

**III. CONCLUSION**

In view of the foregoing, Applicants respectfully request that the Office reconsider and withdraw the rejections of pending claims 47, 61-75, 78-79, and 81-82 as obvious over the cited art.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

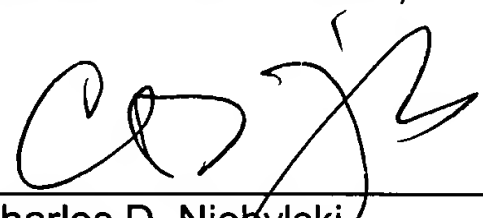
1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Please grant any extensions of time required to enter this response and  
charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By: \_\_\_\_\_

  
Charles D. Niebylski  
Reg. No. 46,116

Dated: March 21, 2002

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

**Appendix:**  
**Changes Made by the Amendment**

47. (Amended) A method of treatment for a disease, wherein the disease is selected from the group consisting of atherosclerosis, cardiovascular disease, diabetes, retinopathy, cataract formation, Parkinson's disease, Alzheimer's disease, Huntington's disease, amyotrophic lateral sclerosis, 21 trisomy, and hypertension, wherein the method comprises administering a replication defective, recombinant adenovirus comprising a DNA sequence which encodes [a] an intracellular CuZn superoxide dismutase-1 (SOD-1), [which regulates superoxide dismutase activity,] wherein the DNA sequence is under the control of a signal enabling expression in a target cell, to a patient suffering from such a disease.

62. (Amended) The method of treatment according to claim 61, wherein the cDNA sequence encodes human intracellular CuZn superoxide dismutase-1 (hSOD-1).

68. (Amended) The method of treatment according to claim 62, wherein the cDNA sequence encodes human intracellular CuZn superoxide dismutase-1 (hSOD1) under the control of an RSV-LTR promoter.

81. (Amended) The method of treatment of any one of claims 69-75, wherein the superoxide dismutase is human intracellular CuZn superoxide dismutase-1 (hSOD1).

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com